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09/751,774	12/29/2000	Stephen T. Stoycos	GEMS:0096/YOD 31-CD-5622	8744
7590	11/07/2003		EXAMINER	
Patrick S. Yoder Fletcher, Yoder & Van Someran P.O. Box 692289 Houston, TX 77269-2289			DOLINAR, ANDREW M	
			ART UNIT	PAPER NUMBER
			3747	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 14

Application Number: 09/751,774  
Filing Date: December 29, 2000  
Appellant(s): STOYCOS ET AL.

Robert A. Manware  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**  
**NOV - 7 2003**  
**GROUP 3700**

This is in response to the appeal brief filed August 29, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-24. Claims 25-32 have been canceled.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is deficient because it fails to refer to the drawing by reference characters as required by 37 CFR 1.192(c)(5).

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

The rejection of claims 1-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

**(8) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

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**(9) Prior Art of Record**

6,035,328	SOUKAL	3-2000
5,662,108	BUDD et al	9-1997

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soukal (US 6,035,328) in view of Budd et al (US 5,662,108). This rejection is set forth in prior Office Action, Paper No. 7, on page 2.

**(11) Response to Argument**

On pages 6 and 7 of the brief, appellant argues that Soukal is directed to sharing of software. This argument does not negate the fact that Soukal has other disclosure that is relevant to the claimed subject matter. "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

In considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences, which one skilled in the art would reasonably be expected to draw therefrom. See *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Appellant further argues, on pages 8 and 9 of the brief, that the examiner has not met the burden regarding evidence or reasoning tending to show inherency.

Soukal discloses data transmitting to the extent claimed at column 1, lines 54-56. Soukal discloses a system of network PCs and a server communicating via an HTTP protocol (column 3, lines 19-53). The terminology implies the conventional features of networks, PCs and servers that are necessarily present in such a system. A server is a device used to store and distribute data to and from PCs. As evidence, see Battersby et al (US 5,740,370). In order for data to be exchanged from one PC to another, it must first be copied to the server, i.e. replicated, since the PCs are not directly connected to each other. Therefore, the claimed replicating step of claims 1 and 13 is inherently disclosed. The system as shown in the drawing figure of Soukal corresponds to applicant's system as shown in FIG. 2 substantially element for element. The system of Soukal has a procedure room (1), a control room (2), a server arrangement (8), local clients (9), and remote clients (10). While applicant's system is disclosed in more detail, the general arrangement is essentially the same.

When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). See MPEP § 2112.02.

As shown above, the examiner has met the initial burden regarding inherency. "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the *prima facie* case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 562 F.2d at 1255, 195 USPQ at 433 (CCPA 1977).

Appellant has provided no evidence that specific structural features of applicant's system as disclosed, which are not taught by the prior art, are necessary to perform the method as

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claimed. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). The general reference to detail of the invention as described in the specification is insufficient to show that specific structural features not disclosed by Soukal are necessary to perform the replicating step as claimed. The claims cannot be construed as requiring the "merge replication" as set forth on page 9 of appellant's specification. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Andrew M. Dolinar


Primary Examiner

Art Unit 3747

AMD

November 5, 2003

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